

## REMARKS/ARGUMENTS

Claims 1-19 remain in this application. Claims 14-15, 17, and 19 have been amended. No claims have been canceled, and no new claims have been added. Claims 20-37 have been withdrawn in response to the restriction requirement, but without prejudice to Applicants' right to present such claims in continuing applications.

### **1. Claim Objections**

Claims 17 and 19 are objected to because of informalities.

Claims 17 and 19 have been amended to address Examiner's concerns.

### **2. Claim Rejections Under 35 USC §112 (Second Paragraph)**

Claims 14 and 15 are rejected under 35 USC 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 14 and 15 have been amended to address Examiner's concerns by changing the dependency of both claims to claim 13.

### **3. Claim Rejections Under 35 USC §102(e)**

Claims 1-3, 5-7, 10-14, and 17-19 are rejected under 35 USC 102(e) as being anticipated by Davies et al., "hereinafter Davies", (US Patent 6,793,728 B1).

Respectfully, the rejection is traversed. Davies is directed to a paint layer which includes zinc powder or alloy for application on a ship's hull for the purpose of protecting the steel hull by a galvanic reaction. The zinc may also form galvanic reaction products (see Col. 4, lines 39-42). This is not a "material exhibiting catalytic activity" as required in claim 1, or a "catalytically active material" as required in claim 13. Catalyst, as defined in Hackh's Chemical Dictionary, 4<sup>th</sup> Edition, is a substance that changes the speed of a reaction, but which is present in its original concentration after the reaction. Accordingly, the form of zinc used in US 6,793,728 is not a catalyst, i.e., it does not function as reaction promoter with its concentration remaining unchanged after the reaction. Further, claims 1 and 13 requires the material to be "porous." Davies '728 does not teach a porous material. Instead, it teaches that the interstices between the zinc particles be filled to create a solid paint layer (see Col. 5, lines 4-6). Accordingly, Davies '728 does not anticipate the claimed invention, as it does not include all the claimed limitations. Dependent claims 2-3, 5-7, 10-12, 14 and 17-19 are not anticipated for at least these reasons.

### **4. Claim Rejections Under 35 USC §103**

Claims 4, 8-9, and 15-16 are rejected under 35 USC 103(a) as being unpatentable over Davies et al., "hereinafter Davies", (US Patent 6,793,728 B1) as applied to claims 1-3, 5-7, 10-14, and 17-19, and further in view of Birkenstock et al., "hereinafter Birkenstock", (US Patent 4,407,733).

Birkenstock does nothing to remedy the basic deficiencies of Davies '728. For the reasons stated above, Davies does not teach a catalyst in the form of a porous coating or porous solid mass. Instead, Davies teaches a solid protective paint layer including zinc. A person of ordinary skill in the art, posed with the problem of creating an improved catalyst material would not look to Davies, a paint, for guidance. It simply offers not suggestion or motivation whatsoever of how to

make a highly effective catalyst. Accordingly, none of the present claims are rendered obvious by the combination of Davies and Birkenstock. Thus, the obviousness rejection should be withdrawn.

**5. Conclusion**

Based upon the above amendments, remarks, and papers of records, Applicants believe the pending claims of the above-captioned application are in allowable form and patentable over the prior art of record. Applicants respectfully request that a timely Notice of Allowance be issued in this case.

Applicants believe that a one month extension of time is necessary to make this Reply timely. Applicants respectfully requests that the Office grant such time extension pursuant to 37 C.F.R. § 1.17(a) as necessary to make this Reply timely, and hereby authorizes the Office to charge the \$120 fee and any necessary fee or surcharge with respect to said time extension to the deposit account of the undersigned firm of attorneys, Deposit Account 03-3325.

Please direct any questions or comments to Randall S. Wayland at 607-974-0463.

Respectfully submitted,



Randall S. Wayland  
Attorney for Assignee  
Reg. No. 36,303  
Corning Incorporated  
SP-TI-03-1  
Corning, NY 14831

Date: 8-4-05